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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,973	04/15/2004	Timothy Nephi Tillotson	10030535-1	7513

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AGILIENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
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EXAMINER

NGUYEN, VAN H

ART UNIT	PAPER NUMBER
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2194

MAIL DATE	DELIVERY MODE
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09/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/824,973	Applicant(s) TILLOTSON ET AL.	
	Examiner VAN H. NGUYEN	Art Unit 2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>05/18/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the application filed 04/15/2004.

Claims 1-20 are presented for examination.

Oath/Declaration

2. The Office acknowledges receipt of a properly signed Oath/Declaration submitted 04/15/2004.

Information Disclosure Statement

3. The Applicants' Information Disclosure Statement, filed 05/18/2004, has been received, entered into the record, and considered.

Specification

4. Examiner requests that Applicant review the application carefully for informalities including typographical errors.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because the abstract *appears to be written as if it were a claim and is not in narrative form*. See MPEP § 608.01(b). Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 8, "the computer" lacks antecedent basis. Claim 8 has no "a computer" term that defines or supports the given reference.

Dependent claims 9-14 are rejected for fully incorporating the deficiencies of their base claim.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7 and 15-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Under a broadest reasonable interpretation, the method claim 1 is unpatentable under section 101 because (i) it does not qualify as a “process” under section 101, as that term has been interpreted by case law, (ii) it seeks to patent an abstract idea, and (iii) the “useful, concrete, and tangible result” test does not apply here, but the claim nevertheless does not meet that test. The method claim 1 differs from traditional process claims in several respects. For example, the claim does not recite any particular way of implementing the steps, nor does it require any machine or apparatus to perform the steps. In addition, the method claim does not recite any electrical, chemical, or mechanical acts or results, which are typical in traditional process claims. Finally, the claim does not call for any physical transformation of an article to a different state or thing. While claim 1 does perform the *obtaining* and *determining* steps, it does not require any machine or apparatus to perform the steps. Because the claim is completely untethered from any sort of structure or physical step, it is directed to a disembodied

concept. In other words, the claim is nothing but a disembodied abstract idea until it is instantiated in some physical way so as to be limited to a practical application of the idea. For example, claim 1 does not specify whether the entity performing the steps of *obtaining* and *determining* is a computer, a human, or something else. Accordingly, the claim is so broad that it is directed to the abstract idea itself, rather than a practical implementation of the concept.

Claim 15 recites "a system" in the preamble only, the body of the claim *merely contains software components*. Therefore, the claim is a program per se and does not fall within at least one of the four enumerated categories of patentable subject matter recited in section 101 (process, machine, manufacture or composition of matter).

Claims which are broad enough to read on statutory subject matter or on non-statutory subject matter are considered non-statutory. Cf. In re Lintner, 458 F.2d 1013, 1015, 173 USPQ 560, 562 (CCPA 1972) ("Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject matter.") During prosecution, applicant can amend to limit the claims to statutory subject matter.

Dependent claims 2-7 and 16-20 are rejected for fully incorporating the deficiencies of their base claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by **Fuller, III et al.**
(US 7134081 B2).

As to claim 1:

Fuller teaches a method for obtaining a client program grammar communication from an Application Programming Interface call, comprising: obtaining the API call; when metadata is associated with the API call, obtaining the associated metadata; and automatically determining a best estimation of the client program grammar communication from the associated metadata and from the API call; and otherwise, automatically obtaining a best estimation of the client program grammar communication from the API call (*see col.4, lines 49-65; col.7, line 47-col.9, line 67; col.13, line 65-col.14, line 62; col.20, lines 17-36; and col.24, lines 53-60*).

As to claim 2:

Fuller teaches the API call is a .NET API call (*see col.24, lines 53-60*).

As to claim 3:

Fuller teaches the client program grammar communication is a Standard Commands for Programmable Instrumentation communication (*see col.20, lines 17-36*).

As to claim 4:

Fuller teaches evaluating the obtained best estimation of the SCPI communication for conformance of the best estimation of the SCPI communication to SCPI specifications (*see col.4, lines 49-65; col.7, line 47-col.9, line 67; col.13, line 65-col.14, line 62; and col.20, lines 17-36*).

As to claim 5:

Fuller teaches when the obtained best estimation of the SCPI communication does not conform to SCPI specifications, manually adjusting the obtained best estimation of the SCPI communication to conform to SCPI specifications (*see col.4, lines 49-65; col.7, line 47-col.9, line 67; col.13, line 65-col.14, line 62; and col.20, lines 17-36*).

As to claim 6:

Fuller teaches evaluating the obtained best estimation of the SCPI communication for conformance of the best estimation of the SCPI communication to General-Purpose Interface Bus specifications (*see col.4, lines 49-65; col.7, line 47-col.9, line 67; col.13, line 65-col.14, line 62; and col.20, lines 17-36*).

As to claim 7:

Fuller teaches when the obtained best estimation of the SCPI communication does not conform to GPIB specifications, manually adjusting the obtained best estimation of the SCPI communication to conform to GPIB specifications (*see col.4, lines 49-65; col.7, line 47-col.9, line 67; col.13, line 65-col.14, line 62; and col.20, lines 17-36*).

As to claims 8-14:

Note the rejection of claims 1-7 above. Claims 8-14 are the same as claims 1-7, except claims 8-14 are computer readable memory device claims and claims 1-7 are method claims.

As to claims 15-19:

Note the rejection of claims 1-4 and 6, respectively. Claims 15-19 are the same as claims 1-4 and 6, except claims 15-19 are system claims and claims 1-4 and 6 are method claims.

As to claim 20:

Fuller teaches GPIB specifications are specified by the Institute of Electrical and Electronic Engineers (IEEE) specification number, IEEE 488.1 (*see col.2, lines 22-55*).

Conclusion

8. The prior art made of record, see PTO 892, and not relied upon is considered pertinent to applicant's disclosure. Applicant should review these references carefully before responding to this office action.

Contact Information

9. Any inquiry or a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN H. NGUYEN whose telephone number is (571) 272-3765. The examiner can normally be reached on Monday-Thursday from 8:30AM-6:00PM. The examiner can also be reached on alternative Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM THOMSON can be reached at (571) 272-3718.

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The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://padirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner for patents
P O Box 1450
Alexandria, VA 22313-1450



VAN H. NGUYEN
PRIMARY EXAMINER